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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,258	09/29/2003	Anu Krappe	79375	3192

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EXAMINER

LABAZE, EDWYN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,258

Applicant(s)

KRAPPE ET AL.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9292003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of IDS filed on 9/29/2003. The examiner has substituted U.S. reference 6,249,199 [which the inventor of said patent is George Liu] as cited in the PTO 1449 with 6,248,199 of Smulson. Should be there any query with this correction, the applicant is respectfully invited to contact the examiner.

2. Claims 1-8 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The disclosure is objected to because of the following informalities: The specifications lack proper titles. The applicant is respectfully requested to add the following titles:

- a) Field of the Invention
- b) Background of the Invention
- c) Brief Summary of the Invention
- d) Brief Description of the Drawings
- e) Description of the Preferred Embodiments

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-2 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakamoto et al. (U.S. 6,330,162).

Re claims 1 and 8: Sakamoto et al. discloses IC card module, manufacturing method therefor, hybrid integrated circuit module, and manufacturing method therefor, which includes comprising a carrier web [described by Sakamoto et al. as a support member 1 onto which the IC chip 2 is placed, see fig. # 1] which comprises circuitry patterns [herein represented by the coil patterns 4 and as shown in figs. # 1-4, 7-8] (col.6, lines 10+), each having an integrated circuit [herein disclosed as the semiconductor chip 45 as shown in fig. # 9] at suitable spaces one after another or next to each other and at least one cover web attached to the carrier web wherein the carrier web and the cover web are attached by a thermoplastic adhesive bonding film web (col.6, lines 50-67; col.7, lines 15+).

Re claim 2: Sakamoto teaches an apparatus and method, wherein the smart card web comprises several cover web layers [disclosed by Sakamoto et al.; but not shown] which are attached to each other by thermoplastic adhesive bonding film webs (col.10, lines 3-24).

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Re claim 6: Sakamoto et al. discloses an apparatus and method, wherein at the location of the chip there is a cavity [or recess grooves as shown in figs. # 2-4, 7] in the cover web (col.2, lines 51+; col.3, lines 20+; col.6, lines 20+).

Re claim 7: Sakamoto et al. teaches an apparatus and method, wherein the thermoplastic adhesive bonding film web is arranged to cover the chip (col.10, lines 15+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al. (U.S. 6,330,162) in view of Peronnet (U.S. 4,303,949).

The teachings of Sakamoto et al. have been discussed above. Sakamoto et al. further teaches a material thermoplastic resin

Sakamoto et al. fails to teach a material of the thermoplastic adhesive bonding film is based on modified polyolefin or polyurethane and the carrier/cover web is made of polyvinyl chloride or polyester.

Peronnet discloses magnetic recording device for providing security related information, which includes a material of the thermoplastic adhesive bonding film is based on modified polyolefin or polyurethane and the carrier/cover web is made of polyvinyl chloride or polyester (col.4, lines 5+).

In view of Peronnet's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Sakamoto et al. a material of the thermoplastic adhesive bonding film is based on modified polyolefin or polyurethane and the carrier/cover web is made of polyvinyl chloride or polyester in order to increase the surface conditions for adhesion. Furthermore, the use of thermoplastic adhesive bonding film made with modified polyolefin or polyurethane and polyvinyl chloride or polyester is well known in the art and other related applications so as to produce thermoplastic adhesive formulations having desired hardness, flexibility and compatibility that are capable of bonding together a variety of substrates [as taught by Kamiyama et al. in US 5,932,301; Matsubayashi et al. in U.S. 4,686,152], and such modification would provide extended stress protection [wherein the card could be bent to a certain radius/arc without breaking the card nor the embedded circuitry] due to the hardness of these resins, and protection means against falsification or substitution of printing laminate of the card due the irreversible bonding of these resins. Moreover, such modification would have been an obvious extension as taught by Sakamoto et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matsubayashi et al. (U.S. 4,686,152) discloses packaging material comprising iron foil, and container and lid composed thereof.

Kamiyama et al. (U.S. 5,932,301) teaches information recording medium and information recording and reproduction method.

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Haghir-Tehrani et al. (U.S. 5,962,840) discloses data carrier with electronic module and embedded coil feature.

Chung (U.S. 6,421,013) teaches tamper-resistant wireless article including an antenna.

Kano et al. (U.S. 6,522,549) discloses non-contact type IC card and method for fabricating the same.

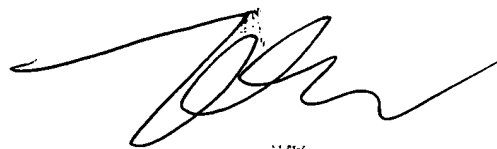
Tsukahara et al. (U.S. 6,780,668) teaches package of semiconductor device and method of manufacture thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
August 25, 2004



THIEN M. LE
PRIMARY EXAMINER